

REMARKS

§101 rejections

In the 23 August 2007 Office Action, claims 28 - 70 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. More specifically the Examiner states that the:

- a) the "claims involves disjointed concepts and ideas based in the abstract, all of which fails to provide a practical application and is insufficient to establish a real world "tangible" result" and
- b) nothing is specified in the claims that limits the claim to a particular application.

These rejections are respectfully traversed by in two ways. First, by noting that the claim rejections fail under both standards of the Administrative Procedures Act and are therefore moot. Second, by noting that the Examiner has failed to establish a prima facie case that would support the rejection of a single claim.

As stated previously, the first way the Assignee will respectfully traverse the rejection of claims 28 – 70 will be by noting that the claim rejections are not in compliance with the requirements of the Administrative Procedures Act and are therefore moot. In *Dickinson v. Zurko*, 119 S. Ct. 1816, 50 USPQ2d 1930 (1999), the Supreme Court held that the appropriate standard of review of USPTO findings of fact are the standards set forth in the Administrative Procedure Act ("APA") at 5 U.S.C. 706 (1994). The APA provides two standards for review – an arbitrary and capricious standard and a substantial evidence standard. The Supreme Court has defined substantial evidence as "substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. . . Mere uncorroborated hearsay or rumor does not constitute substantial evidence. Consolidated, 305 U.S. at 229-30 (citations omitted)". The Assignee respectfully submits that the instant Office Action fails to provide even a scintilla of evidence to support the allegations of non utility and the lack of claim limitations it contains and that as a result it fails to meet the substantial evidence standard.

The Assignee respectfully submits that the 23 August 2007 Office Action also fails to pass the arbitrary and capricious test. In the *Gartside* decision (In re Gartside 203F.3d 1305, 53

U.S.PQ2d 1769 (Fed Circuit 2000)) the First Federal Circuit discussed the arbitrary and capricious standard when it noted:

Because this standard is generally considered to be the most deferential of the APA standards of review, (see Stein et al., Administrative Law 51.03, at 51-117 (1999)) the reviewing court analyzes only whether a rational connection exists between the agency's fact-findings and its ultimate action, (see Hyundai Elecs. Indus. Co. v. ITC, 899 F.2d 1204, 1209, 14 USPQ2d 1396, 1400 (Fed. Cir. 1990).

The Assignee respectfully submits that the claim rejections 23 August 2007 Office Action also fail to pass the arbitrary and capricious test because:

1. as noted previously, the Examiner has not completed any discernible fact-finding that can rationally or irrationally be connected to the rejections contained in the Office Action for an alleged lack of limitations and/or an alleged lack of utility;
2. there is no rational connection between the U.S.P.T.O. fact-findings in Meynard (U.S. Patent 7,096,299) and the findings that claims 28 – 36 and 51 – 53 represent non-statutory subject matter. In Meynard the U.S.P.T.O. found that transferring context information for a computer was statutory subject matter. Given this finding, it is irrational and unreasonable to state that developing, distributing and using context information for an entity, as described in claims 28 – 36 and claims 51 – 53, is non-statutory;
3. there is no rational connection between the U.S.P.T.O. fact-findings in Pack et al (U.S. Patent 7,249,342) and the findings that claims 37 - 45 and 70 represent non-statutory subject matter. In Pack the U.S.P.T.O. found that using context information to complete a specific task (mask writing) was statutory subject matter. Given this finding, it is irrational and unreasonable to state that developing and using context information to complete a plurality of specific tasks, as described in claims 37 – 45 and 70, is non-statutory;
4. there is no rational connection between the U.S.P.T.O. fact-findings in Bachman et al (U.S. Patent 7,216,121) and the finding that claims 46 – 50 and 54 – 69 represent non-statutory subject matter. In Bachman the U.S.P.T.O. found that using a context to support the completion of a query was statutory subject matter. Given this finding, it is irrational and unreasonable to state that developing and using a context to support the completion of a search, as described in claims 46 – 50 and 54 – 69, is non-statutory; and

5. there is no rational connection between the U.S.P.T.O. factfindings in the prosecution of the instant application and the decision to issue the Meynard, Pack et al and Bachman et al. patents (among others).

The second way the claim rejections will be traversed will be by noting that the Examiner has failed to establish a prima facie case that any of the claims are directed to non-statutory subject matter. It is well established that *"the examiner bears the initial burden ... of presenting a prima facie case of unpatentability."* *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Instead of presenting a prima facie case, the Examiner has made two unsupported statements:

1. the "claims involves disjointed concepts and ideas based in the abstract, all of which fails to provide a practical application and is insufficient to establish a real world "tangible" result" and
2. nothing is specified in the claims that limits the claim to a particular application.

The first statement is an innuendo regarding an alleged lack of utility. *MPEP 2164.07 states "the examiner has the initial burden of challenging an asserted utility. Only after the examiner has provided evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the applicant to provide rebuttal evidence sufficient to convince one of ordinary skill in the art of the invention's asserted utility. In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995) (citing *In re Bundy*, 642 F.2d 430, 433, 209 USPQ 48, 51 (CCPA 1981)). The Examiner has not presented any evidence that any of the claimed functions have no practical utility, are not concrete, are not tangible and/or are not useful. In short, the Examiner has failed to establish a prima facie case that could be used to sustain the §101 rejection of any of the rejected claims 28 – 70. The second statement appears to raise additional questions about the objectivity and level of skill in the art of those reviewing the application. For the reasons stated above, the removal of the §101 claim rejection for every claim is respectfully requested.

Statement under 37 CFR 1.111

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. 37 CFR 1.111 states in part that:

In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections.

The Assignee notes that this requirement is not relevant to the instant application because, as detailed above, there are no references or objections to avoid. Having said that, the Assignee notes that the primary reason the prior set of claims were amended was to put the application in a final form for allowance and issue.

Reservation of rights

The Assignee hereby explicitly reserves the right to present the previously modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,

/B.J. Bennett/

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